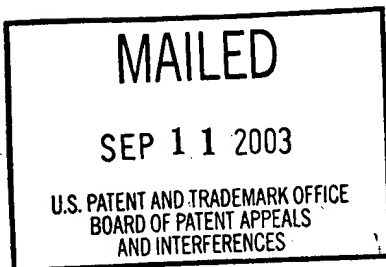


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RONALD J. BOSER

Appeal No. 2003-1346
Application No. 09/944,612

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the item listed below.

In reviewing the examiner's answer (Paper No. 12, mailed December 16, 2002), we note that the examiner has rejected claim 1 on appeal under 35 U.S.C. § 103(a) as being unpatentable over Fairbanks et al. (U.S. Patent No. 2,613,365). In the body of that

rejection, the examiner takes Official Notice and then concludes that the claimed subject matter would have been obvious to one of ordinary skill in the art from the combined teachings of Fairbanks et al. and the Official Notice. In the response to argument section of the answer (page 8), the examiner makes note of two articles¹ that support the examiner's taking of Official Notice. The examiner does not utilize these articles in the rejection currently on appeal. In the reply brief (Paper No. 13, filed January 27, 2003), the appellant objects (page 2) to the use of the two articles.

On REMAND the examiner should consider the memorandum issued to the Patent Examining Corps by Deputy Commissioner for Patent Examination Policy, Steven G. Kunin, entitled "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice," dated February 21, 2002,² and rely upon documentary evidence properly applied in the 35 U.S.C. § 103(a) rejection if such is available and appropriate. See also MPEP § 2144.03. As noted by the Court of Customs and Patent Appeals in In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

¹ The Gershman article and the "Living Easier with VELCRO" article.

² Copy attached.

Under the circumstances set forth above, e.g., new prior art relied upon in the answer, we are of the view that no supplemental examiner's answer should be permitted in this case.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D). It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMANDED



NEAL E. ABRAMS
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2003-1346
Application No. 09/944,612

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JVN/jg